

REMARKS

This Amendment is submitted in response to the Office Action dated June 10, 2003. In the Office Action, the Patent Office objected to Claims 10-14 alleging that the claims have informalities. The Patent Office rejected Claims 1-6, 8, 9, 15-18, 20, 21, 23, 24, 28 and 30 under 35 U.S.C. §102(b) as being anticipated by *Kinzenbaw et al.* (U.S. Patent No. 5,346,019). Further, the Patent Office rejected Claims 7, 19, 22, 25, 29 and 31 under 35 U.S.C. §103(a) as being unpatentable over *Kinzenbaw et al.* in view of *Taylor et al.* (U.S. Patent No. 4,725,068).

By the present Amendment, Applicant amended Claims 10, 21-23 and 25-31. Applicant submits that the application is in condition for allowance in view of the amendments and for the reasons that follow. Notice to that effect is requested.

Applicant notes with appreciation that the Patent Office indicated that Claims 10-14, 26 and 27 are allowable.

In the Office Action, the Patent Office objected to Claims 10-14 alleging that the claims have informalities. More specifically, the Patent Office alleged that Claims 10-14 were improper because line 9 of Claim 10 makes reference to wording "the axis" wherein no antecedent basis exists for the wording. In response, Applicant amended Claim 10 to delete the word "axis" and add the word "axle." Applicant asserts that an antecedent basis exists for the word axle. Therefore, Applicant asserts that the objection of the

Patent Office has been overcome. Notice to that effect is requested.

The Patent Office rejected Claims 1-6, 8, 9, 15-18, 20, 21, 23, 24, 28 and 30 under 35 U.S.C. §102(b) as being anticipated by *Kinzenbaw et al.* (U.S. Patent No. 5,346,019). The Patent Office alleged:

"*Kinzenbaw et al.*, discloses an apparatus including a frame, axle, cylinder, discs, a controller, a pillar 1018 a column 100b inside the pillar, liner 180b and plates 182b inside the pillar supporting the column as shown in figures 3d & 6. *Kinzenbaw et al.* further discloses a hitch 18 and tires 32 and a plug (considered the wheel not numbered but shown in figure 1b & 1c, or 166 in figure 4. Concerning claim 15, *Kinzenbaw et al.* discloses a front cross bar 22, rear cross bar 24 and a beam (25a, 26a, 26b or 25b). Concerning claim 28, *Kinzenbaw et al.* discloses an apparatus including a frame discs, tires 32, a pillar 118 including a liner 180b and a front cylinder 108. Concerning claim 24, cylinder 80 of *Kinzenbaw et al.* is considered the front cylinder."

However, Claims 1-6, 8, 9, 15-18, 20, 21, 23, 24, 28 and 30 each define features not disclosed by *Kinzenbaw et al.* More specifically, independent Claim 1 defines an apparatus for separating soil having a frame.

Independent Claim 1 defines an apparatus for separating soil. The apparatus has a frame and an axle associated with the frame. The frame moves by pivoting with respect to the axle.

Kinzenbaw et al. do not disclose a frame which pivots with respect to the axle. In *Kinzenbaw et al.*, the frame is merely raised or lowered; however, the raising or lowering of the frame is not the same type of movement as the pivoting defined in

Independent Claim 1.

Independent Claim 15, as amended, defines a frame having a first set of discs and a second set of discs. Movement of the first set of discs toward the soil causes movement of the second set of discs away from the soil.

Kinzenbaw et al. do not disclose a frame having discs wherein movement of a first set of discs toward the soil causes movement of a second set of discs away from the soil. In *Kinzenbaw et al.*, all of the discs are moved in the same direction simultaneously when the frame is moved.

Independent Claim 21, as amended, defines a frame having a plurality of discs. One of the plurality of discs is moved towards the soil causing one of the plurality of discs to be moved away from the soil. As stated above, in *Kinzenbaw et al.*, all of the discs are moved in the same direction simultaneously when the frame is moved.

Independent Claim 23, as amended, defines a frame wherein movement of the first end of the frame toward the soil causes movement of the second end of the frame away from the soil. However, in *Kinzenbaw et al.*, movement of the first end of the frame toward the soil causes movement of the second end of the frame toward the soil as well.

Independent Claim 24 defines a frame which is moved by a front cylinder which adjusts an angle of the frame relative to the soil.

However, in *Kinzenbaw et al.*, the angle of the frame relative to the soil remains constant.

Independent Claim 28, as amended, defines an apparatus for separating soil. The apparatus has a frame having a body defined by a plane. In *Kinzenbaw et al.*, the frame is not defined in a plane. Rather, the frame has two portions defining separate planes.

Independent Claim 30, as amended, defines a frame having discs. An axle is associated with the frame. Movement of the discs does not change a position of the axle. However, in *Kinzenbaw et al.*, the axle is moved simultaneously with the discs and moves in the same direction as the discs. Therefore, a position of the axle does change when the discs are moved.

Under 35 U.S.C. §102(b), anticipation requires that a single reference disclose each and every element of Applicant's claimed invention. *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1479, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986).

Moreover, anticipation is not shown even if the differences between the claims and the reference are "insubstantial" and one skilled in the art could supply the missing elements. *Structure Rubber Products Co. v. Park Rubber Co.*, 749 F.2d. 707, 716, 223 USPQ 1264, 1270 (Fed. Cir. 1984).

Because *Kinzenbaw et al.* fails to disclose each and every element of independent Claims 1, 15, 21, 23, 24, 28 and 30, the

rejection of these claims under 35 U.S.C. §102(b) is improper and should be withdrawn. Notice to that effect is requested.

The Patent Office rejected Claims 7, 19, 22, 25, 29 and 31 under 35 U.S.C. §103(a) as being unpatentable over *Kinzenbaw et al.* in view of *Taylor et al.* (U.S. Patent No. 4,725,068). In the Office Action, the Patent Office alleged:

"*Kinzenbaw et al.* discloses an apparatus as described previously, including a hitch 18. *Kinzenbaw et al.*, however lacks specifying that a connector that rotates 360 degrees, is used with the hitch. *Kinzenbaw et al.*, does however show holes in the hitch that are used to connect the hitch to a towing vehicle (fig. 1a).

Taylor et al. teaches that it is known in the art to use a pin 84 to connect an implement frame to a tow vehicle. Pins are used as connecting devices as they allow for quick and easy connections. The examiner notes that although a tightened bolt often cannot be rotated, a pin such as the ones used with agricultural devices to provide quick connections can in fact rotate 360 degrees. Therefore, the use of a connecting pin that can rotate 360 degrees within its' aperture would meet the claimed limitation of the connector rotating 360 degrees."

As stated previously, independent Claim 1 defines an apparatus for separating soil. The apparatus has a frame and an axle associated with the frame. The frame moves by pivoting with respect to the axle. Neither *Kinzenbaw et al.* nor *Taylor et al.*, taken either singly or in combination teach or suggest a frame which pivots with respect to the axle. In *Kinzenbaw et al.*, the frame is merely raised or lowered; however, the raising or lowering of the frame is not the same type of movement as the pivoting defined in Independent Claim 1. *Taylor et al.* provide no teaching of a frame which pivots with respect to an axle.

Independent Claim 15, as amended, defines a frame having a first set of discs and a second set of discs. Movement of the first set of discs toward the soil causes movement of the second set of discs away from the soil.

Neither *Kinzenbaw et al.* or *Taylor et al.*, taken either singly or in combination, teach or suggest a frame having discs wherein movement of a first set of discs toward the soil causes movement of a second set of discs away from the soil. In *Kinzenbaw et al.*, all of the discs are moved in the same direction simultaneously when the frame is moved. *Taylor et al.* merely teach a type of hitch for a frame.

Independent Claim 22, as amended, defines a frame having a body defined by a plane. Neither *Kinzenbaw et al.* or *Taylor et al.*, taken either singly or in combination, teach or suggest a frame having a body defined by a plane. In *Kinzenbaw et al.*, the frame has two portions defining separate planes.

Independent Claim 25, as amended, defines a frame having a length defined between a first end and a second end. The frame moves along a pillar and pivots at a point between the first end and the second end. Neither *Kinzenbaw et al.* nor *Taylor et al.*, taken either singly or in combination, teach or suggest a frame which pivots at a point between a first end and a second end and moves along a pillar. In *Kinzenbaw et al.*, the frame moves along the pillar; however, the frame does not pivot.

Independent Claim 29, as amended, defines an apparatus for

separating soil having a frame. One or more pillars are associated with the frame wherein the frame is moved along the body of each of the pillars. Neither *Kinzenbaw et al.* nor *Taylor et al.*, taken either singly or in combination, teach or suggest a frame which moves one or more pillars. In *Kinzenbaw et al.*, the apparatus has a single pillar along which the frame is moved. *Kinzenbaw et al.* do not provide a teaching or suggestion for movement of the frame along the body of one or more pillars associated with the frame.

Independent Claim 31, as amended, defines an apparatus for separating soil having a frame. An axle is associated with the frame. A plurality of discs are also associated with the frame wherein movement of the discs does not change a position of the axle. Neither *Kinzenbaw et al.* nor *Taylor et al.*, taken either singly or in combination, teach or suggest a frame having discs wherein movement of the discs does not affect a position of the axle. In *Kinzenbaw et al.*, the position of the axle is dependent on the position of the discs. Specifically, when the discs are moved, the axle is also moved.

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the

invention as a whole, in light of all of the teachings of the references in their entirety, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

In view of the foregoing remarks and amendments, Applicant respectfully submits the rejections of Claims 7, 19, 22, 25, 29 and 31 under 35 U.S.C. §103(a) have been overcome and should be withdrawn. Notice to that effect is requested.

Claims 2-9 depend from Claim 1; Claims 11-14 depend from Claim 10; and Claims 16-20 depend from Claim 15. These claims are further believed allowable over the references of record for the same reasons set forth with respect to their parent claims since each sets forth additional structural elements and novel steps of Applicant's hydraulic disc/harrow apparatus and method for using the same, respectively.

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicant

urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that this **Amendment** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on October 02, 2003.



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